

## **REMARKS**

The following remarks are prepared in response to the Office Action of March 17, 2006.

Claims 1-7, 9-16 and 18-28 remain pending in this application, after entry of this amendment.

Reconsideration in light of the amendments and remarks made herein is respectfully requested.

### **Rejection of Claims 1-7, 9-16 and 18-28 Under 35 U.S.C. § 103(a)**

Claims 1-7, 9-16 and 18-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Porcher* (U.S. Patent No. 4,702,022, hereinafter *Porcher*) in view of *Dalvy et al.* (U.S. Patent No. 5,924,218, hereinafter *Dalvy*), *Mashita et al.* (U.S. Patent No. 5,681,649, hereinafter *Mashita*), *Finn* (U.S. Patent No. 3,410,004, hereinafter *Finn*) and *Farrior* (U.S. Patent No. 6,691,431, hereinafter *Farrior*). Applicant respectfully traverses.

### **Independent Claims 1, 18, 23 and 28**

Independent claims 1, 18, 23 and 28 recite a boot comprising a pad disposed in the toe box or the heel counter area where the pad is tapered at the edges and thickest in the middle. On page 2 of the Office Action, the Examiner states that *Porcher* does not disclose a gel pad located between any of the layers in the toe box area or the heel area or the gel pad tapered at the edges and thickest in the middle. However, the Examiner asserts that *Farrior* teaches that a gel pad located within footwear can gradually taper in a direction outwardly from the center. The Examiner asserts that since these two references relate to footwear, they can be combined. Applicant asserts that no explicit or implicit teaching, suggestion or motivation exists to combine *Farrior* with *Porcher*.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the

knowledge generally available to one of ordinary skill in the art. M.P.E.P. § 2143.01. The test for an implicit showing is what (1) the combined teachings of the prior art, (2) the knowledge of one of ordinary skill in the art, and (3) the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

The Examiner has not identified any explicit teaching, suggestion or motivation to combine a dance shoe as disclosed in *Farrior* with a ski boot as disclosed in *Porcher*. Since the Examiner has failed to specifically identify any explicit teaching, suggestion or motivation to combine the references and Applicant has found no explicit teaching, suggestion or motivation to combine the references, Applicant will now discuss why there is no implicit teaching, suggestion or motivation to combine the references.

#### **References Do Not Suggest the Desirability of the Combination**

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). *Porcher* does not suggest the desirability of the combination with *Farrior*. *Porcher* discusses a ski boot without any mention of a pad near the wearer's toes or heel. *Porcher* actually seeks to provide a novel solution to closing a ski boot (col. 1, lns. 32-33). For example, FIG. 1 shows a manually-operable relief valve 13 for providing communication between the vacuum chamber 5 and the atmosphere in order to inflate the vacuum chamber and open the boot (col. 3, lns. 19-22). *Porcher* also claims and discloses a ski boot comprising a substantially rigid casing (claim 1 and col. 1, lns. 36-40). *Farrior* discloses a way to improve the look of a dancer's foot that is undetectable and that does not impede the dancer's ability to perform intricate dance movements. One skilled in the ski

boot art would not look to a flexible, aesthetic device that improves the look of a dancer's foot when looking for improvements to a substantially rigid ski boot. Ski boots are designed to impede the user's foot, contrary to what is desired by a dancer. Hence, the references do not suggest the desirability of the combination.

**Combining the References Is Not Within the Knowledge of One of Ordinary Skill**

A statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made because the references relied upon teachings that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention.). No objective reason exists to combine a ski boot with an aesthetic foot device.

*Porcher* discloses a ski boot and *Farrior* discloses an aesthetic foot device. *Porcher* does not mention any reason to look to an aesthetic foot device for combination with a ski boot. *Farrior* discourages the solution claimed because the claimed invention recites a boot comprising a pad disposed in the toe box or the heel counter area where the pad is tapered at the edges and thickest in the middle. The heel pad provides protection to the heel and the toe pad provides protection to the toes. *Farrior's* foot device, on the other hand, provides no protection to the heels or toes. Rather, *Farrior's* foot device augments the appearance of a dancer's foot (col. 2, lns. 38-40). Accordingly, *Porcher* and *Farrior* fail to provide any objective reason why

one of ordinary skill in the art would combine the teachings of these references, and therefore, combining the references is not within the knowledge of one of ordinary skill in the art.

### **References Solve Different Problems**

Each reference is directed to solving a different problem.

*Porcher* actually seeks to provide a novel solution to closing a ski boot (col. 1, lns. 32-33). The background in *Porcher* states the continuing research into reducing the number of operations that need to be performed in order to clamp together a foot and a ski boot (col. 1, lns. 16-18). *Porcher* relates to a ski boot in which the boot is clamped to the foot by a vacuum system (col. 1, lns. 4-5).

*Farrior* discloses a way to improve the look of a dancer's foot that is undetectable and that does not impede the dancer's ability to perform intricate dance movements (col. 1, lns. 61-63). The background in *Farrior* states that in the dance arts such as ballet, modern dance, jazz and the like, the physical attributes of the dancer are of utmost importance (col. 1, lns. 10-12). *Farrior* relates generally to the dance arts and more particularly to improvements in the appearance of a dancer's foot (col. 1, lns. 6-8). One skilled in the ski boot art would not even look at *Farrior* because its main purpose is to improve the appearance of a dancer's foot.

Because each reference is directed to solving a different problem, no motivation exists to combine the references to arrive at the claimed invention.

### **Dependent Claims 2-7, 9-16 and 19-27**

Claims 2-7, 9-16 and 19-27 depend from independent claims 1, 18 and 23, adding structural features that more particularly define the invention and further distinguish over the cited references and the prior art of record. For these reasons, and for the reasons set forth above

for claims 1, 18, 23 and 28, the rejection of these dependent claims under 35 U.S.C. § 103(a) is improper and should be withdrawn.

### Conclusion

If the Examiner believes that a telephone interview will help further the prosecution of this case, he is respectfully requested to contact the undersigned attorney at the listed telephone number.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 17, 2006.

By: Lisa Holstein



Signature

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Very truly yours,

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